

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of:

William D. SWART

Serial No.: 09/973,081

Filed: October 10, 2001

For: VIDEO AND DIGITAL MULTIMEDIA
ACQUISITION AND DELIVERY
SYSTEM AND METHOD

Atty. Docket No.: 007412.00259

Group Art Unit: 2421

Examiner: Saltarelli, Dominic D.

Confirmation No.: 5256

REPLY BRIEF

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Sir:

This is a Reply Brief filed in response to the Examiner's Answer of mailing date October 27, 2009, and in support of Appellant's February 26, 2009, Notice of Appeal. This Reply Brief is **not** intended to serve as a substitute for Appellant's Appeal Brief filed July 17, 2009, but rather, as a supplement to the Appeal Brief in order to more fully clarify the issues for appeal.

Please charge any fees due, or credit any overpayments made, to Deposit Account No. 19-0733. In addition, any extensions of time necessary for acceptance or entry of this paper are hereby requested.

Remarks

The Examiner's Answer contains illogical and legally erroneous positions.

The Answer begins addressing Appellant's arguments at page 11 by referring to Appellant's prior remarks regarding the combination of Hendricks, Kenner, Campanella, Farry, and Hoarty, and more specifically, the use of different multiplexing technologies with respect to Campanella (utilizing frequency division multiple access ("FDMA")) and Farry and Hoarty (utilizing time division multiplexing ("TDM")). The Answer at page 12 contends that Hendricks discloses a functioning distribution system and seemingly therefore concludes that there is "simply no need or benefit (thus no motivation) to modifying said distribution system to alter either the multiplexing method used or the frequency bands utilized by Hendricks. The proposed combinations for which there is a need or benefit . . . are entirely unrelated to which type of multiplexing method is used or which frequency bands are utilized."

Appellants disagree with the reasoning contained in the Answer (at pages 11-12). Indeed, the reasoning contained therein amounts to little more than a simple assertion that the references can be combined. *See MPEP § 2143.01 (III) (Fact That References Can Be Combined Or Modified May Not Be Sufficient To Establish Prima Facie Obviousness).* As discussed at page 5 of the Appeal Brief, MPEP § 2141.02 (VI) (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)) provides that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. (Emphasis in original). When the references are read as a whole, as required by the MPEP, the claimed features are not obvious because the references, and more particularly the communications technologies

described therein, are incompatible with one another. Indeed, the proposed combination of Farry and Hoarty with Campanella would impermissibly change the principle of the (FDMA) communications of Campanella. *See MPEP § 2143.01 (VI) (The Proposed Modification Cannot Change The Principle Of Operation Of A Reference)* (providing that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious); *see also MPEP § 2142* (providing that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness and if the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness).

The Answer (and the Final Office Action mailed November 17, 2008) fails to establish a *prima facie* case of obviousness with respect to the appealed claims. Accordingly, Appellants respectfully request withdrawal of the section 103 rejections of record.

Conclusion

In view of the foregoing and for reasons set forth more fully in Appellants' Appeal Brief, reversal of the appealed rejections is respectfully requested.

Respectfully submitted,
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Dated: December 28, 2009